

REMARKS

Claims 1-41 are pending in the application. Claims 1, 21, 36 and 40 are currently amended.

Claims 1-41 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Publication No. 2003/0088771 to Merchen. Applicants respectfully request reconsideration of the claim rejections in view of the following remarks. Applicants contend that at the very least, claims 1, 21, 36 and 40 are patentably distinct and patentable over Merchen.

For instance, with regard to claims 1 and 21, Merchen does not disclose or suggest, e.g., *removing the patient identifying information from the patient data record to generate a de-identified data record comprising unencrypted patient data in the patient data record which does not identify the patient.*

Moreover, with regard to claims 36 and 40, Merchen does not disclose or suggest, e.g., *generating a de-identified data record comprising unencrypted data in the data record which does not identify the individual.*

On a fundamental level, the teachings of Merchen are different from the claimed inventions as originally filed and as amended. In the Response to Arguments section of the Final Action, the Examiner contends that Merchen's teachings of maintaining the "secrecy of patient information" via encrypting reads on the originally filed claims because such encryption essentially "removes the ability for unauthorized users to assess a particular patient information..." However, it is respectfully submitted that these arguments are not on point.

To begin, the anticipation rejections are premised, in part, on a strained and legally improper claim interpretation. For instance, with regard to claim 1, the rejections are essentially based on the characterization of the claimed step of *removing the patient identifying information in the patient data record to generate a de-identified data record* to be the same or similar to the use of encryption as taught by Merchen.

This interpretation is unreasonable for various reasons. For one, this interpretation is improperly based on a vacuum interpretation that attempts to fit the claim language to the teachings of Merchen with *no* consideration given to the teachings in Applicants' specification with regard to the scope and meaning of the claim language. The Office Action offers no support of this interpretation of the claim language based on teachings in Applicants' specification.

Moreover, this interpretation is at odds with principles of plain meaning of the claim language because the process of "*removing the patient identifying information in the patient data record ...*" is grammatically and semantically different from "*incorporating encryption and hashing techniques*", as essentially interpreted by the Office Action in view of Merchen's teachings. The contention that the claimed "removing" step is met by the teachings of Merchen because "*Merchen's privacy and secrecy elements, clearly **removes the ability** for unauthorized users to assess a particular patient information...*" (emphasis added) misses the point - the claims recite "removing the patient identifying information" not "removing the ability to assess patient information".

Moreover, the Response to Arguments fails to consider the distinction between “*patient information*” and “*patient identifying information*”. For example, in the proper context of claim 1, the process of *removing the patient identifying information from the patient data record to generate a de-identified data record*, for example, involves removing patient identifying information from a data record so that a de-identified data record with other patient information can be disclosed to third parties for research, analysis, etc., while maintaining the privacy of the patient’s identity. Merchen encrypts the entire data record to maintain secrecy of all information inclusive of patient identifying information and other health information, which is fundamentally different from the claimed inventions. Again, in proper context, the Examiner’s argument that encryption maintains “secrecy of patient information” is not fully on point because the Applicants’ specification teaches methods for enabling disclosure of patient health information to entities that are authorized to use the patient health information for analysis, screening, etc., but not necessarily authorized to re-identify the patient.

Notwithstanding the above, Applicants have amended the claims in the interests of cooperation and for the sole purpose of expediting prosecution and making clear the already clear distinctions between the claimed inventions and the disparate teachings of Merchen. At the very least, Merchen does not disclose or suggest *a de-identified data record comprising unencrypted patient data in the patient data record which does not identify the patient*, as essentially claimed in claims 1, 21, 36 and 40.

In view of the above, it is respectfully submitted that the subject matters of claims 1, 21, 36 or 40, at the very least, are patentably distinct and patentable over Merchen.

Moreover, all claims depending from claims 1, 21, 36 and 40 are patentably distinct and patentable over Merchen at least by virtue of their dependence from respective base claims 1, 21, 36 and 40. Accordingly, withdrawal of the rejections is requested.

Dated: June 26, 2007

Respectfully submitted,

Francis Montgomery

Francis Montgomery

Reg. No. 41,202

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
(732) 321-3130